

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Alina A. Boutah

Examiner: Alina A. Boutah

Serial No: 09/584,810

Art Unit: 2143

Filed: May 31, 2000

Docket: YOR920000196US1 (13539)

For: UNIVERSAL CONVERSION SERVER

Dated: June 3, 2008

Confirmation No.: 2276

Hon. Commissioner for Patents
United States Patent and Trademark Office
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REPLY BRIEF

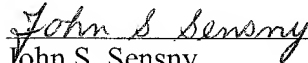
Sir:

Pursuant to 35 U.S.C. 134 and 37 C.F.R. 41.41, entry of this Reply Brief in response to the Examiner's Answer in the above-identified matter, is respectfully requested.

CERTIFICATE OF ELECTRONIC FILING

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Date: June 3, 2008



John S. Sensny

Appellants note that they have received three Examiner's Answers in this appeal. One Answer is dated April 3, 2008, the second Answer is dated May 14, 2008, and the third is dated May 22, 2008. These Answers appear to be substantially identical. Appellants are proceeding on the basis that the latest Answer, dated May 22, 2008, indicates the Examiner's current position, and this Reply is a reply to that May 22, 2008, Answer.

I. Introduction

Appellants have appealed the rejection of Claims 1-5 and 7-19 under 35 U.S.C. 103 as being unpatentable over U.S. Patent 6,092,114 (Shaffer, et al.) in view of U.S. Patent 6,549,918 (Probert, Jr. et al.) and further in view of a document titled "Conversion Service" (CERN).

The rejection of claims 1-5 and 7-19 should be reversed because the prior art does not render obvious using the same computer both to determine if a data file is compatible with the computer's operating system and to transmit that data file over the Internet to a Universal Server (as described in independent Claims 1, 8 and 12) or to a Universal Driver (as described in independent Claim 7) for conversion. Claim 1 is representative of Claims 8 and 12.

II. Discussion

Appellants' Brief in support of this appeal was filed before the Supreme Court decision in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), and accordingly, KSR was not discussed in that Brief. A careful review of that decision, and other applicable case law, shows,

however, that the KSR decision does not change Appellants' basic conclusion – that Claims 1-5 and 7-19 are patentable over the cited prior art and that the Examiner's rejection of these claims should be reversed. This is because KSR does not change the basic framework, as explained in Graham v. John Deere Co., 383 U.S. 1 (1966), for determining obviousness; and when judged by that framework, the differences between the claims on appeal in this case and the prior art are such that those differences would not have been obvious to one of ordinary skill in the art.

In KSR, the Supreme Court reiterated that the appropriate test of obviousness under its precedence is an application of the Graham factors: the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc, when present must be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented, Graham, at 17-18.

In the present case, the differences between the claims and the prior art is that, with the claims of this application, the same computer is used both to determine if a data file is compatible with the computer's operating system and to transmit that data file over the Internet to a Universal Server or to a Universal Driver for conversion.

The Examiner argues that this difference is obvious. Appellants respectfully disagree. This is because modifying the method and system disclosed in Shaffer, et al. so as to operate in accordance with the present invention is contrary to the teachings of Shaffer, et al.

Shaffer, et al describes a method and system for exchanging electronic messages. If these messages are not in the proper format, they are sent to a server for conversion. In the Abstract, Shaffer, et al. expressly states that the invention is for “isolating personal computers and other client devices from the process of converting...”. Clearly, this teaches away from using that computer to do more of the conversion process – as is done in the present invention.

Likewise, Probert, Jr. et al. also teaches away from the present invention.

Probert, Jr., et al. describes an operating system layer between software components or application programs that expect information to be in one format and a persistent store manager of the operating system that maintains the information in this persistent state. This operating system is used to provide “on the fly” transformation between the file format expected by the application layer and the format used by the persistent store manager.

Thus, the intent or goal of Probert, Jr., et al. is to perform the transition “on the fly.” This teaches that delays are undesirable. However, the present invention, by sending the data file to a server, introduces such delays. In the context of the present invention, those delays are acceptable. This difference between the present invention and Probert, Jr., et al. is due, in part to the fact that this invention and Probert, Jr., et al. address two different specific problems. The present invention provides a method and system for users who may be using relatively simple computers to obtain the data file in a form suitable for the computer’s operating system – and this is done by sending the incompatible data file to a Universal Server or Driver, which may be provided with all the hardware and software needed to perform conversions for a large number of users and computers.

Probert, Jr. et al, in contrast, is directed to providing a dynamic solution that, as mentioned above, operates “on the fly” and does not require a separate server. Because of this, one of ordinary skill in the art would not be led to modify the Probert, Jr. et al. method or system to send the data files to a separate server.

CERN was cited by the Examiner for its teaching of allowing users to upload files over the Internet from a user’s station to be converted. Among other differences between the present invention and CERN, this reference does not disclose using the computer to determine that the file is not compatible with the computer’s operating system. Instead, with the CERN procedure, the computer user determines what files to send for conversion.

Thus, even if Shaffer, et al. and Probert, Jr. et al. could be modified to operate in accordance with the present invention, it would not have been obvious to one of ordinary skill in the art to modify these references in these ways.

Independent Claims 1, 8 and 12 clearly set forth the above-discussed difference between the present invention and the prior art. Specifically, these claims describe the features that the computer determines whether the format of the file is compatible with the computer operating system, and if the data file is not compatible with the computer, that computer transmits that data file over the Internet from the computer to a universal server, which then transforms the file into a format compatible with the computer.

Analogous to Claim 1, Claim 7 describes the feature that a computer determines if data, entered into the computer, is compatible with the operating system in the computer. As described in Claim 7, if the format of that data is not compatible with the computer, that

computer sends that data over a network to a remote universal driver, which then reformat that data into a format compatible with the computer.

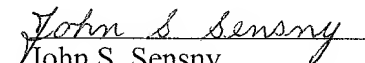
III. Conclusion

In light of the above-discussed differences between Claims 1, 7, 8 and 12, and the prior art, and because of the advantages associated with those differences, it cannot be said that any of these claims is obvious in view of that prior art. Hence Claims 1, 7, 8 and 12 patentably distinguish over the prior art. Claims 2-5 and 17-19 are dependent from Claim 1 and patentably distinguish over the prior art therewith. Also, Claims 9-11 are dependent from Claim 8 and patentably distinguish over the prior art therewith; and Claims 13-15 are dependent from, and patentably distinguish over the prior art with, Claim 12.

Thus, the rejections of Claims 1-5 and 7-19 over Shaffer, et al. in view of Probert, Jr. et al. and further in view of CERN is not proper, and the Board is respectfully requested to reverse these rejections.

Respectfully submitted,

Dated: June 3, 2008


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